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10/526,364	09/06/2005	Dietmar Pennig	7202-78	3372
30448	7590	08/11/2006	EXAMINER	
AKERMAN SENTERFITT P.O. BOX 3188 WEST PALM BEACH, FL 33402-3188			WOODALL, NICHOLAS W	
			ART UNIT	PAPER NUMBER
			3733	

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/526,364

Applicant(s)

PENNIG, DIETMAR

Examiner

Nicholas Woodall

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>03/01/2005</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in the European Patent Office on 09/03/2002. It is noted, however, that applicant has not filed a certified copy of the European application number EP20020019637 as required by 35 U.S.C. 119(b).

### ***Specification***

1. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that

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the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because it uses a phrase that relates, e.g. "The present invention relates". Also the abstract is written in claim form and not in narrative form. Correction is required. See MPEP § 608.01(b).

4. The disclosure is objected to because of the following informalities: Page 7 lines 11-12 and lines 14-15 contain a plurality of periods followed by a plurality of question marks. Appropriate correction is required.

### ***Drawings***

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: reference numbers 6 and 11 are not shown in the figures submitted with the application. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of

any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the intermediate plate element being as an open washer integrally formed with a flange portion as stated in claims 8 and 22 must be shown or the feature(s) canceled from the claim(s). Also, the transversal hole nearest the head of the screw comprising at least a partial thread as stated in claim 14 must be shown or the feature(s) cancelled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

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the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

7. Claim 3 is objected to because of the following informalities: the claim states, "said enlarged arm portions". The examiner recommends changing this to, "said elongated portions to be in accordance with claim 1. Appropriate correction is required.

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-11 and 13-22 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, and 5-16 of copending Application No. 10/526366. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 1, 2, and 5-16 of the copending application and claims 1-11 and 13-22 of the application

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lies in the fact that the copending application claims 1, 2, and 5-16 include many more elements and is thus much more specific. Thus the invention of claims 1, 2, and 5-16 are in effect a "species" of the "generic" invention of claims 1-11 and 13-22. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claims 1-11 and 13-22 are anticipated by claims 1, 2, and 5-16 of the copending application, they are not patentably distinct from claims 1, 2, and 5-16.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claim 23 is rejected under 35 U.S.C. 102(b) as being anticipated by Halloran (U.S. Patent 3,709,218).

Regarding claim 23, Halloran discloses a method of using an intramedullary fixation element that comprises proximal transverse holes. The method includes producing an incision in the tissue surrounding the bone to access the fracture. The method also includes a step of inserting an intermediate plate and passing a screw through the plate. The head of the screw is abutted against the surface of the plate and

is separated from the bone surface by the intermediate plate element (column 3 lines 53-67 and column 4 lines 1-42).

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1-7, 9-12, and 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halloran (U.S. 3,709,218) in view of Niiranen (U.S. 6,692,498).

Regarding claim 1, Halloran discloses a system that comprises an intramedullary fixation element (21), an intermediate plate element (28), and at least one locking screw (27). The intramedullary fixation element (21) comprises at least one proximal transversal holes (25). The intermediate plate (28) is slightly bent to fit against the bone surface. Regarding claim 2, Halloran discloses an intermediate plate element (28) that contains a slight bend to better adhere to the bone surface. Regarding claim 9, Halloran discloses a system wherein a second intermediate plate is used with a second locking screw. Regarding claim 15, Halloran discloses a fastening device, the device comprises an intermediate plate element (28) that is slightly bent to better adhere to the surface of the bone. Regarding claim 16, Halloran discloses a fastening device wherein the intermediate plate element (28) is slightly curved to better adhere to the surface of the bone. Halloran discloses the claimed invention except for the intermediate plate element comprises a couple of elongated arm portions that are in a position astride of a set screw (claim 1), that the elongated arm portions are rounded on the ends (claims 3 and



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17), the intermediate plate element comprises an enlarged portion having at least a seat for embracing a fixation element (claims 4 and 18), the seat is at least a hole formed in the elongated portion of the intermediate plate element (claims 5 and 19), the seat is at least a hole in one of the elongated arm portions of the intermediate plate element (claims 6 and 20), the intermediate plate has a substantially rounded profile (claims 7 and 21), the second intermediate plate element comprises a couple of elongated arms (claim 11). Niiranen teaches an intermediate plate element that can be manufactured to any number of forms and sizes desired in order to best utilize the plate for the desired use of the plate (column 9 lines 23-50; claims 1, 3, 4, 7, 11, 17, 18, 19, and 21).

Niiranen shows a Y-shaped plate that has elongated arms inherently able to be placed astride of a screw and an enlarged portion. The arms of the plate are shown to be substantially rounded. Niiranen teaches that the intermediate plate element may contain a plurality of holes in order to pass fasteners through the plate (column 9 lines 37-39; claims 4, 5, 6, 18, 19, and 20). Niiranen shows the holes passing through different areas of the plates including what would be the arms and enlarged portions of the Y-shaped plate. It would have been obvious to one having ordinary skill in the art at the time of the invention to manufacture the system of Halloran with the shapes and plurality of holes of the plates of Niiranen in order to best utilize the plate for the desired use and to allow the passage of fasteners through the plate. Regarding claims 10 and 12, Halloran in combination with Niiranen discloses the claimed invention except for the second intermediate plate element being larger than the first intermediate plate element and that the arms of the second intermediate plate element are larger than the arms of the

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first intermediate plate element. It would have been an obvious matter of design choice to make the second intermediate plate element and the arms of the plate larger in size than the first intermediate plate element and the arms of the plate, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

14. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Halloran (U.S. 3,709,218) in view of Niiranen (U.S. 6,692,498) and in further view of Leu (U.S. 6,270,499).

The combination of Halloran and Niiranen discloses the claimed invention except for the intramedullary fixation element comprising threaded transverse holes. Leu teaches an intramedullary fixation element comprises threaded bores in order to accurately position the intramedullary fixation element (column 3 lines 53-56). It would have been obvious to one having ordinary skill in the art at the time of the invention to manufacture the intramedullary fixation element of Halloran as modified by Niiranen with the threaded bores in view of Leu in order to accurately position the intramedullary fixation element.

### ***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for cited references the examiner felt were relevant to the application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is 571-272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NWW



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